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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,827	03/04/2004	Patrick Arachquesne	P24953	3641
26360 7590 09/11/2007 RENNER KENNER GREIVE BOBAK TAYLOR & WEBER FIRST NATIONAL TOWER FOURTH FLOOR 106 S. MAIN STREET AKRON, OH 44308				
EXAMINER				
CLEMENT, MICHELLE RENEE				
ART UNIT		PAPER NUMBER		
3641				
MAIL DATE		DELIVERY MODE		
09/11/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,827

Applicant(s)

ARACHEQUESNE, PATRICK

Examiner

Michelle (Shelley) Clement

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim requires that the sight device be both a holographic sight and a red dot sight device, applicant's arguments have stated that they cannot be one in the same and there is nothing in the specification to indicate that they are the same. In view of applicant's arguments it is not clear how the sight device can be both a holographic sight and a red dot sight device.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 60 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Booth (US Patent # 6,671,990) in view of Tai et al (US Patent # 5,483,362). Booth discloses a firearm comprising at least one barrel having a muzzle end (reference 19) and an opposite end (reference 18). Booth discloses a rail attached to the barrel that can be utilized to mount sighting devices to the barrel. Booth does not explicitly teach a holographic sight mounted on the firearm. Tai et al. teaches a holographic sight for mounting on firearms. All of the component parts are known in the references. The only difference is the combination of the old elements into a single device by mounting them on the mounting rail at the specific spot closer to the muzzle end. It would have been obvious to one having ordinary skill in the art to mount the holographic sight taught by Tai et al. onto a standard firearm and mounting rail as shown by Booth, since the operation of the holographic sight is in no way dependent on the operation of the other equipment of the firearm, and a sight could be used in combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. It is noted that holographic sights are known for having unlimited field of view and unlimited eye relief, and therefore the placement of the holographic sight on the barrel and the distance of the sight from the users eye is independent of the sights ability to work as intended and is merely related to individual preference (See cited nonpatent literature for the characteristics of holographic sights) (See MPEP 2124 for references cited for showing factual characteristics and properties known at the time of invention). The [a) statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. It is noted that the

Art Unit: 3641

holographic sight device **has the ability** of being mounted at any desired point on the barrel. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

5. Claims 49-55, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Booth and Tai et al. as applied to claim 60 above and further in view of Sanders (US Patent # 5,046,277) and Tai et al. (US Patent # 66,490,060). Sanders teaches a specific mounting means that can be used for mounting any type of sighting device to a firearm. The mounting means being removable and comprising a groove, formed on a firearm extending along a groove direction from a proximal end to a distal end and open at the proximal end, the firearm comprises an abutment that is arranged and disposed such that when a matching strip is received in the groove and is submitted to a force along a longitudinal direction extending from the muzzle end to the opposite end, the strip is blocked in the longitudinal direction towards the muzzle end but is free to move in a direction toward the opposite end. The groove is a dovetail groove and is essentially parallel to the longitudinal direction. An abutment is provided at the distal end of the

groove. The groove is provided near or at the muzzle end and is provided on at least one lateral side of the rifle. The barrel comprises a longitudinal rib (reference 162) on top of the barrel and the mounting means are structured so that an end part of an intermediary plate comes flush with the rib and a sight device would be fixated to the end part. Tai et al. '060 teaches a specific sighting device mounting means comprising a strip having a shape to be received and guided in a groove of a mounting means on a firearm. The strip has a dovetail shape. The mounting means comprises an intermediary arc shaped plate extending from the strip and fixed to the sight device. The intermediary arc shaped plate is structured so that it supports the sight device so that the sight device is on top of the barrel. Because the references teach firearms, sights and mounts devices for firearms and sights, it would have been obvious to one skilled in the art to substitute one mount and sight for the other because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/
Primary Examiner, Art Unit 3641